

### **REMARKS**

In response to the non-final Office Action of June 22, 2011, a New Sheet of drawings containing a new Figure 5 is enclosed showing an insert ("slug") that is tapered. Support for new Figure 5 and its description in the specification as set forth in the proposed amendment to the specification is in the application as originally filed, including original claim 14 which states that the reservoir is provided with an insert that is tapered. No new matter is added.

Claim 18 has been amended in a manner as suggested by the Office at section 3 of the Office Action and has also been amended in response to the rejection at section 5 so as to make clear that the glass annulus is the space between the end of the reservoir and the slug. Support for this amendment is found in the original application as filed, including Figure 3 and its description in the specification, including paragraph [0040] of the published application. No new matter is added.

### **Drawings:**

At section 2, the drawings are objected to for not showing every feature specified in the claims; specifically, the tapered slug as discussed in claim 14. A new drawing sheet is enclosed containing a new Figure 5 corresponding to Figure 3, but showing the slug as tapered. Since the original application as filed referred to the insert/slug as tapered as discussed above, it is respectfully submitted that this new drawing does not introduce new matter. Consequently, its description in the specification as amended herein is also believed not to introduce new matter.

### **Claim Objections**

At section 3, claim 18 is objected to concerning use of the word "from". Amendment has been made in the manner suggested by the Office.

**Claim Rejections – 35 USC §112**

At section 5, claims 11, 13, 14, and 18 are rejected under 35 USC §112, second paragraph as being indefinite. Specifically, with respect to claim 18, the Office states that the limitation “a glass annulus” is unclear as to whether the glass annulus is an actual object or if it is merely the space between the slug and the reservoir. Appropriate amendment has been made to claim 18, specifically stating that the indents providing dimples on the inside surface of said reservoir thereby form a glass annulus at the end of said reservoir. Further amendment has been made to claim 18 to state that the recited slug can be held by said dimples against said glass annulus.

Thus, it is made clear that the glass annulus is the space between the end of the reservoir and the slug and it is therefore respectfully submitted that claim 18, as amended, is definite and complies with 35 USC §112, second paragraph.

Consequently, claims 11, 13, and 14 which ultimately depend from claim 18 are also definite.

**Claim Rejections – 35 USC §103**

At section 7, claims 1, 3, 6-9, and 17 are rejected under 35 USC §103(a) as unpatentable over US patent 3,001,524, Maison, et al (hereinafter Maison), in view of US patent 4,085,616, Patel, et al (hereinafter Patel).

The Office asserts that with respect to claim 1, Maison shows the recited dispenser except that it fails to disclose a minor portion in the form of a tapered tip having a comparatively small cross section. The Office asserts that Patel shows a reservoir comprising a minor portion and a major portion with the minor portion having a smaller relative cross section and the reservoir being a transparent plastic material with the minor portion opposite the discharge outlet and the minor portion in the form of a tapered tip to allow for more accurate measurement of the fluid when a small volume of fluid is in the container. The Office further asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have implemented the Patel teaching of a tapered bottom reservoir with the Maison reservoir

to allow for more accurate measurement of the fluid when a small volume of fluid is in the container.

For the reasons presented below, it is respectfully submitted that claim 1 is distinguished over Maison in view of Patel and therefore applicant respectfully requests reconsideration of the rejection of claim 1.

Specifically, Maison discloses an aerosol dispensing apparatus comprising an aerosol dispensing container 10 and an application member 38/58 (Maison, column 3, lines 30-32). The container comprises self-propelling, medicament containing compositions containing a liquefied, propellant gas as the means of discharging medicament in aerosol form (Maison, column 2, lines 1-3). Figure 9 shows an embodiment of the apparatus which is designed to be used in a valve-down orientation. As described at column 5, lines 15-17 the liquid in this configuration then falls towards the valve so that it can be dispensed.

The dispenser shown in Figure 9 of Maison does not, however, have a reservoir that has a major portion with a comparatively large cross-section and a minor portion in the form of a tapered tip so that when a user inverts that dispenser so its valve is up, the level of the substance in the minor portion can be observed. Rather, the reservoir in Maison has a normal non-tapered shape (see Figure 9).

The Office recognizes that this feature is not disclosed in Maison and argues that a person of ordinary skill in the art would note this feature in Patel and incorporate it into the dispenser of Maison.

The applicant respectfully submits that a person of ordinary skill in the art would not combine the teachings of Maison and Patel.

More particularly, Patel is concerned with a device for measuring and collecting a discharge of liquid and, in particular, urine (Patel, column 1, lines 9-11). The device is designed to obtain information during the natural voiding of urine such as total flow, average flow rate, force, velocity and configuration of the stream (Patel, column 1, lines 13-19). The device therefore comprises a receptacle to receive and measure the urine

discharge and a lower container to receive the discharge from the receptacle (Patel, column 1, lines 31-35).

The device of Patel is therefore for collecting a liquid substance, namely urine. In contrast, the device in Maison is for dispensing an aerosol (Maison, column 1, lines 12-15). The devices are therefore designed to achieve entirely opposite effects, namely collecting in Patel and dispensing in Maison. Accordingly, there is no motivation whatsoever for a person of ordinary skill in the art to combine their teachings.

The container 24 in Patel, which the Office asserts the person of ordinary skill in the art would incorporate into the aerosol dispenser of Maison, has flexible side walls (98a, 98b) that are joined by heat or radio frequency (Patel, column 4, lines 36-39). The example of the material given to make the side walls is polyethylene (Patel, column 4, lines 43-44). Such a container is essentially a bag and could not be successfully used in the aerosol dispensers disclosed in Maison. As discussed above, the container 10 in Maison contains a liquefied propellant gas as a means of discharging the medicament in aerosol form. The container is therefore under pressure and must maintain this pressure in order for the aerosol to be successfully dispensed. This would not be achieved by a container as described in Patel. The flexible walls of the container 24 in Patel would simply deform under the pressure of the propellant. Pressure loss would inevitably occur and the medicament would not be successfully delivered.

Another reason why a person of ordinary skill in the art would not incorporate the container 24 of Patel into the dispenser of Figure 9 of Maison is that container 24, comprising flexible walls, is not designed for use in an inverted position. As discussed above, the container 24 in Patel is essentially a shaped bag for collecting a discharge of urine. As such, it is designed for use in the tapered end down orientation. The dispenser shown in Figure 9 of Maison, however, is designed to be used in an inverted position. Thus, if the container 24 of Patel were to be incorporated into the dispenser of Figure 9, the container 24 would, in use, be tapered end up. A container with flexible walls, i.e., a bag, cannot, however, remain upright in this position. Rather, it would flop

over with the liquid in the flopped over end thereby potentially impacting on the flow of medicament to the valve and ultimately the dispensing of the medicament. This results from the fact that the container 24 in Patel is for collecting liquid, while container 10 in Maison is for dispensing medicament.

On a related point, it is also notable that the container 24 of Patel shown in Figure 1 does not have indications all the way down to its tip. This is because in use the container will fill up with urine. In the aerosol dispenser of Maison, however, the content of the container diminishes over time and all the way down to the end of the tip. Again, this shows the fundamental difference between Maison, wherein the container discharges medicament, and the container of Patel, wherein liquid urine is collected.

For all of the foregoing reasons, it is therefore respectfully submitted that the asserted combination of Maison and Patel would not be obvious to one of ordinary skill in the art and even if combined would not operate in the manner as suggested by the Office. In fact, the proposed modification of Maison in view of Patel would in fact render Maison unsatisfactory for its intended purpose in view of the fact that the reservoir in Patel would be unsuitable for use in a pressurized dispenser as disclosed in Maison. It is clear that the proposed combination of Maison and Patel therefore falls within MPEP §2143.01 V; that is, that the proposed modifications cannot render the prior art unsatisfactory for its intended purpose. In fact, the very case cited in section V of §2143.01 is analogously applicable to the present situation.

In particular, section V cites *In re Gordon*, 733 F.2d 900 221 USPQ 1125 (Fed. Cir. 1984). In that particular case, the claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were collected at the bottom end of the filter assembly, and wherein a gas vent was present at the bottom of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board

concluded the claims were *prima facie* obvious, reasoning that it would have been obvious to turn the reference device upside down. The Federal Circuit reversed finding that if the prior art device was turned upside down, it would be inoperable for its intended purpose, because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline and the screen would become clogged.

Thus, analogously to the decision in support of section V of 2143.01, the combination of Maison with Patel would be unsatisfactory for the intended purpose of Maison.

In view of the foregoing, it is respectfully submitted that claim 1 is distinguished over the cited art.

Since independent claim 1 is allowable, it is respectfully submitted that dependent claims 3, 6-9, and 17 are also allowable at least in view of their ultimate dependency from an independent claim which is allowable.

Applicant notes that at section 9, claims 11, 13, 14, and 18 would be allowable if rewritten to overcome the rejections under 35 USC §112, second paragraph. That rejection has been overcome and therefore these claims are also believed to be allowable.

In view of the foregoing, it is respectfully submitted that the present application as amended is in condition for allowance and such action is earnestly solicited.

The Commissioner is hereby authorized to charge to deposit account 23-0442 any fee deficiency required to submit this paper.

Respectfully submitted,

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